

REMARKS

Amendments presented herewith cancel claim 15.

Claims 1-14 and 16-18 are pending in the application.

Claim 15 was rejected under 35 U.S.C. 112, second paragraph. Claim 13 has not been subject to rejection or object and believed to be allowable if rewritten in independent form. Claims 1-2, 5-8, 11-12 and 16 stand rejected under 35 U.S.C. 102(b) as anticipated by Ciotti (20030185262). Claim 3 stands rejected under 35 U.S.C. 103 (a) as unpatentable over Ciotti in view of Abler (20060185262). Claim 4 stands rejected under 35 USC 103(a) as unpatentable over Ciotti in view of Morris (5966956). Claims 9-10 and 12 stand rejected under 35 U.S.C. 103(a) as unpatentable over Ciotti in view of WO9802626. Claims 14, 17 and 18 stand rejected under 35 U.S.C. 103(a) as unpatentable over Ciotti in view of Morris taken with Fagnoni, Howroyd and Mears.

Rejection under 35 USC 112, second paragraph:

Claim 15 having been canceled, this rejection is believed to have been rendered moot.

Rejection under 35 U.S.C. 102(b):

Claims 1-2, 5-8, 11-12 and 16 stand rejected under 35 U.S.C. 102(b) as anticipated by Ciotti (20030051417).

A review of the cited reference indicates that the disclosure therein relates to a construct similar in nature to that presently claimed. However, contrary to the Examiner's conclusion of anticipation, applicant would urge that the reference fails to

disclose every limitation of the presently rejected claims.

Specifically, Claim 1, on which the remaining claims depend, requires that the claims construct is a:

“container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction,”

Simply put, the cited reference neither describes or suggests such structural integrity to be a feature or characteristic of the construct disclosed.

In order for a reference to be anticipatory within the meaning of 35 USC 102, that reference must teach each and every limitation of the claimed invention.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F. 3d 1292, 63 USPQ2d 1597 (Fed.Cir.2002); See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the....claim. Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the instant case, the reference fails to account for the claim required limitation relating to the structural integrity of the construct.

Therefore, applicant would respectfully request reconsideration and withdrawal of the instant rejection as applied to claims 1-2, 5-8, 11-12 and 16.

Rejection under 35 U.S.C. 103(a):

Rejection over Ciotti in view of Abler (20060185262):

At pages 5-6 of the Office action of October 14, 2008, the Examiner has set forth the reasoning in support of the rejection of claim 3 as being unpatentable over the combination of Ciotti and Abler.

The Examiner acknowledges that Ciotti is silent with regard to locking means for the floor and wall portions when they are in a substantially vertical orientation in the disassembled state. However, the Examiner urges that Abler discloses a similar building construction having hinged wall portions for forming an expanded floor where in a closed position the building is an ISO shipping container, and further discloses that the portions having locking means for freighting.

The Examiner concludes that it would have been obvious to modify the building of Ciotti to have the locking means of Abler to provide a secure container for shipping.

Applicant would initially note, as discussed above relative to the rejection under 35 U.S.C. 102, that neither reference provides that which is missing from the Ciotti reference as to the structural integrity limitation of claim 1 on which claim 3 depends. Applicant would also emphasize the difference in the construct of Ciotti and that of Abler. Clearly the construct of Ciotti includes, in each disclosed construct, multiple portions, beyond a roof and floor as claimed, connected to the individual sides of the center portion of the construct. Abler reasonably appears to disclose a single roof and/or floor portion for each construct or at least each side of the center portion. It appears reasonable that the difference could eliminate the need in the Ciotti construct

for a locking mechanism since the multi paneled system itself may provide the basis for keeping the various elements of the construct in place while disassembled. What is clear is that there is no suggestion in Ciotti for a need or advantage to include such a locking mechanism in the construct. Thus, the question becomes why incorporate a limitation or element into the construct if it is not needed. That Abler would suggest such a need does not necessarily carry over to all such constructs and is not clearly applicable to the construct of Ciotti.

The test of obviousness is not whether something could be done. The mere fact that something could be done is not the standard of obviousness under 35 U.S.C. § 103. The prior art must suggest the desirability of such a combination or modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Further, "obviousness requires a suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Here, the combination of Ciotti and Abler fail to account for the structural integrity limitation. Further, the prior art does not readily suggest why one would modify the construct of Ciotti with the locking mechanism of Abler when Ciotti does not suggest the need for such locking of the various components.

Thus, applicant would request reconsideration and withdrawal of this ground of rejection.

Rejection over Ciotti in view of Morris (5966956):

At pages 6-7 of the Office action of October 14, 2008, the Examiner sets forth the reasoning in support of the rejection of claim 4 as being unpatentable over the combination of Ciotti, previously discussed, with Morris.

With regard to this ground of rejection, the applicant would again note that Morris fails to provide that which is additionally missing from the Ciotti disclosure. Claim 4 depends on claim 1 and therefore includes the limitation relating to the structural integrity as discussed above. Neither Ciotti nor Morris disclose or suggest this limitation. As noted in the arguments relative to the previous rejection under 35 U.S.C. 103, the prior art must account for each and every limitation presented in the claim. Since the two references fail to do so, they do not provide an adequate basis for rejecting the claims under 35 U.S.C. 103(a).

Applicant request reconsideration and withdrawal of this rejection.

Rejection over Ciotti in view of WO 9802626:

At pages 7-8 of the Office action of October 14, 2008 the Examiner sets forth the reasoning in support of the rejection of claims 9-10 and 12 as being unpatentable over the combination of Ciotti and the WO 9802626 patent.

While citing Ciotti as previously discussed, the Examiner acknowledges that Ciotti "does not disclose a removable corner protector arranged over at least part of an external edge or along a different external edge of the disassembled construction to provide a measure of protection and/or strength when it is being transported." However, the Examiner cites the WO 9802626 patent as disclosing a foldable, portable building

construction comprising removable corner protector 26 to aid in moving the building when being transported. The Examiner concludes that it would have been obvious to modify the construction of Ciotti to include the corner protectors of WO982626 to aid in safely and efficiently transporting the construction, such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent the four corners of the building construction without causing structural damage thereto.

Applicant would initially note that there is nothing that would suggest the need in the construct of Ciotti for such corner protectors as urged by the Examiner. Further, the applicant would note that the teaching of the WO9802626 patent actually supports applicant's previous arguments as presented relative to the rejection of claim 1. In applicant's invention the "removable corner protectors" are stated to **protect and add** strength to the structure. (See Spec. page 9, lines 4-6). According to the WO9802626 patent the corner framing described is intended for "use in carrying and facilitating loading and unloading of the container-sized collapsed building" (See page 9, lines 26-33 in discussing connectors 26 of Fig. 16). Clearly, this reasonably suggests that the WO9802626 patent does not provide that which is missing from the disclosure of Ciotti, i.e. a structural integrity which would permit the construct to be moved, stacked and loaded without damage even in the absence of corner framing devices. There is nothing in Ciotti which would suggest the need for additional structure to assist in the moving and loading of the disassembled construct. It remains that the teachings of the two references find structure only when viewed through the teaching and claims of the present invention.

For these reasons, applicant would urge that the combination of Ciotti and the

WO9802626 patent do not account for each and every limitation of the claimed invention, since claims 9-10 and 12 depend from claim 1 and do not readily suggest the specific claim limitation of these claims. Applicant requests reconsideration and withdrawal of the present rejection.

Rejection over Ciotti, combined with Morris, and referenced by Fagnoni (4534141), Howroyd (4464868) or Mears et al. (882573)¹:

At pages 8-9 of the Office action of October 14, 2008, the Examiner sets forth the support for the rejection of claims 14, 17 and 18 as unpatentable over Ciotti taken in view of Morris and referenced by Fagnoni, Howroyd and Mears et al.

The Examiner acknowledges that Ciotti and Morris “do not disclose that the construction is formed such that when the roof portion is swung out to an installed position by way of its pivot connection or connections the roof portion is angled upwards away from the main portion so that parts of the roof portion most remote from the main portion are substantially higher than parts of the roof portion immediately adjacent the main portion, and wherein the position of contact between the adjacent the main portion and wherein the position of contact between the roof portion and the main portion is inherently covered by the roof portion to substantially assist in resisting rain water entering the building construction when the building construction is completely installed.”

However, the Examiner cites Fagnoni, Howroyd or Mears as disclosing portable container building constructions with foldable wall extensions where the gap between

¹ Applicant would note that it was not possible to identify the Mears reference since it did not correspond to a US patent and was not listed on the PTO-892 included with the Office action. Applicant would note that Kuhn (6772563) which was listed on the PTO-892 but not relied upon includes a disclosure of the type shared by both Fagnoni and Howroyd.

the main portion and the expandable wall portion is covered to resist rain water from entering the building construction.

Further, the Examiner urges that while the references do not expressly disclose that the roof portions are angled such that the more remote portion is higher than the parts of the roof portion adjacent the main portion, that it is common and well known to have different designed angled roof portions to affect the aesthetic design and interior functionality of a space whether angled up or down.

Initially, applicant would note that Claim 14, on which 17 depends, requires that “the position of contact between the roof portion and the main portion **is inherently covered by the roof portion to substantially assist in resisting rain water** entering the building construction when the building construction is completely installed” (Emphasis added.). This is exemplified in Figures 7-10 of the Specification which makes clear that the “roof portion” overlaps the main portion to resist rain water entering the building. Applicant would note that neither Ciotti nor Morris disclose this limitation. Further, applicant would note that review of by Fagnoni, and Howroyd makes clear that in every case, it is the main portion of the construct that overlaps the roof portion in the disassembled state. (Note drawings in each document). Thus, the combination of references relied upon by the Examiner, do not account for or suggest this claim limitation.

As to claim 18, applicant would again note the claim limitation that requires that in the claimed construction the roof portions and the floor portions provide structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight

container on top of it, in either case without causing structural damage to the building construction.”

Again, the references relied upon by the Examiner simply do not account for this claim limitation as discussed through out this response. Note: In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (See also, MPEP, section 2146.03) (Both previously cited).

As to the Examiner’s contention that having the roof portion angled upwards away from the main portion so that parts of the roof portion most remote from the main portion are substantially higher than parts of the roof portion immediately adjacent the main portion” would have been a design feature, applicant would note that no evidence has been submitted for this premise. Further, given the clear concern of the art concerning rain water, applicant would urge that it would not have been obvious to adapt a construction that would serve to actually direct rain water back to the main portion rather than away from it. This is the driving force that makes most construction employ pitched roofs in order to remove or carry water or snow away from the principle structure.

For these reasons, applicant would urge that the present rejection of claims 14, 17 and 18 are improperly based, fail to account for all claim limitations and the conclusion of obviousness is not supported by the evidence of record. Applicant would therefore request reconsideration and withdrawal of this rejection.

Conclusion:

In this response applicant has canceled claim 15 and provided arguments directed to all prior art rejections. Applicant, respectfully, requests reconsideration and

withdrawal of these rejections in light of the arguments and discussion presented.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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